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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,227	04/16/2004	Andrew E. Fano	33836.00.0046	9661
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ACCENTURE C/O VEDDER PRICE KAUFMAN & KAMMHOLZ, P.C. 222 NORTH LASALLE STREET CHICAGO, IL 60601			EXAMINER PENG, FRED H	
			ART UNIT 2623	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/826,227

Applicant(s)

FANO ET AL.

Examiner

Fred Peng

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/04/2004, 10/18/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-7, 9-15, 22-26, 28-31, 34-39 and 42-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Lopez-Estrada et al (US 2003/0035648).

Regarding Claims 1, 4, 38 and 39, Lopez-Estrada discloses an apparatus with corresponding method for controlling the time required to review multi-media program material comprised of:

a multi-media playback unit, capable of selectively playing back segments of a multi-media program (FIG.2C; element 30);

a memory wherein program instructions are stored to perform the function (Para 28);

a first controller, operatively coupled to said multi-media playback unit and to memory (Para 28), said controller having at least one input performing the functions of:

i) selecting for playback from multi-media program material, a first segment of the multi-media program material, based on a first criteria (Para 22 lines 1-8; playback a first segment based on a requested chapter); and

ii) suppressing the playback of a second segment of the multi-media program material, based on the content of the at least one second segment (Para 22 lines 8-14; skip a second segment if the segment is not the requested chapter); and

iii) selecting for playback from the multi-media program material, a third segment of the multi-media program material, based on the first criteria (Para 22 lines 8-18; play a third segment if the segment is the requested chapter).

Regarding Claims 2 and 3, Lopez-Estrada further discloses said first criteria and said second criteria are comprised of indexes within said multi-media program material that identifies the beginning of a segment (Para 22 lines 1-5; chapter label is an index identifying the beginning of a segment).

Regarding Claim 5, Lopez-Estrada further discloses said second segment is ordered after said first segment and said third segment is ordered after said second segment in said multi-media program material (Para 23 lines 22-30; scene 1 is first segment, commercial in between is second segment and scene 2 is third segment).

Regarding Claim 6, Lopez-Estrada further discloses the third segment is ahead of the first segment (Para 27; DVD inherently play preview, the second segment, before feature program; the segment after the second segment is the third segment).

Regarding Claim 7, Lopez-Estrada further discloses said first segment selected for playback includes a segment of video of a first portion of said multi-media program material and a segment of audio of a second portion of said multi-media program material (Para 16 lines 8-10).

Regarding Claim 9, Lopez-Estrada further discloses first criteria including a user's preferences to playback predetermined content (Para 27 lines 8-12).

Regarding Claim 10, Lopez-Estrada further discloses said first criteria includes a user's specified playback time of said multi-media program material (Para 20 lines 1-4).

Regarding Claim 11, Lopez-Estrada further discloses the step of selecting for playback, includes the steps of:

viewing said multi-media program material;

identifying content segments in said multi-media program material that conform to at least one criteria (Para 20);

indexing said content segments by adding an index in said multi-media program (Para 20; segments identified as chapters); and

detecting an index in said multi-media program material to identify said first segment to playback (Para 20).

Regarding Claim 12, Lopez-Estrada further discloses viewing said multi-media program material; and annotating said multi-media program material (Para 20).

Regarding Claim 13, Lopez-Estrada further discloses a user-specified time period, during which said multi-media program material is to be reviewed (Para 20 lines 1-4).

Regarding Claim 14, Lopez-Estrada further discloses the content for display is selected based on data embedded in said multi-media program material (Para 27).

Regarding Claim 15, Lopez-Estrada further discloses the content for display is selected based on data transmitted with said multi-media program material (FIG.2B).

Regarding Claim 22, Lopez-Estrada discloses a method for controlling the time requires to review multi-media program material comprised of:

previewing said multi-media program material;

adding an index to said multi-media program material by which selected segments of said multi-media program material can be identified for selective playback according to information in said annotation (Para 20).

Regarding Claim 23, Lopez-Estrada further discloses adding an index includes adding an annotation that complies with an MPEG standard (Para 17).

Regarding Claim 24, Lopez-Estrada further discloses adding an index is comprised of adding an annotation that includes a specification of the start time and stop time of information in said multi-media program material that conforms to a specification (Para 20 lines 1-5).

Regarding Claims 25 and 26, Lopez-Estrada further discloses adding an annotation that that substantially contemporaneously describes information in said multi-media program material and is imbedded in the multi-media program (FIG.2B, element 22; Para 21 lines 10-17).

Regarding Claims 28 and 29, Lopez-Estrada further discloses storing and transmitting said multi-media program material and said index on a storage media from which said program material can be played back and from which said annotation can be detected (FIG.2B; element 26; Para 26).

Regarding Claims 30 and 31, Lopez-Estrada discloses a method of adding content to a multi-media program, said method comprised of:

detecting a viewer's input control signal to a multi-media playback device (FIG.2B, elements 23 and 24; Para 19);

adding a content segment to a first multi-media program in response to the user's input control signal and the added content segment is third party advertising content (Para 23 lines 22-30; add a commercial between 18 and 23 minutes into the program).

Regarding Claim 34, Lopez-Estrada further discloses suspending the display of said multi-media program on a display device; and displaying said content segment on said display device while the display of said multi-media program is suspended (Para 22 lines 22-30; the program is suspended when the commercial is played).

Regarding Claim 35, Lopez-Estrada further discloses transitioning the display of first and second segments of said multi-media program; and adding said content segment between said first and second segments of said multi-media program (Para 23 lines 22-30).

Regarding Claim 36, Lopez-Estrada further discloses adding a content segment is performed in response to a user's manual specification to suspend playback of said multi-media program (Para 22 lines 22-30; the program is suspended in response to user's input of 18-23 minutes into the program).

Regarding Claim 37, Lopez-Estrada further discloses suppressing the display of a segment of said multi-media program responding to the user input (Para 19 lines 7-15; locate a desired point indicating suppressing a segment).

Regarding Claims 42, 43 and 44, Lopez-Estrada further discloses a data network carrying indexed multi-media content (FIG.2B; Para 10) which are received and output to a display device (FIG.2C; Para 22).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8, 18-21 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez-Estrada et al (US 2003/0035648).

Regarding Claim 8, Lopez-Estrada discloses multi-media program material (Para 12) but not specifically about multi-media program material is comprised of at least one of a televised sporting event.

The Official Notice is taken that it is well known in the art that multi-media program material is comprised of at least one of a televised sporting event.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a televised sporting event as one of the most popular event for television.

Regarding Claims 18, 19 and 33, Applicant admits it is well known in the art to blend an added content segment with a multi-media program (Specification Para 91).

Official Notice is also taken that it is well known in the art that the overlay segment is either semi-transparent or opaque.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include playing a multi-media program on a predetermined area of a display device with added content segment being presented substantially simultaneously with the display of said multi-media program.



Regarding Claims 20 and 21, Lopez-Estrada is silent about overlay content is determined by a user preference.

The Official Notice is taken that it is well known in the art to send a reminder or a message to a user to watch or record a program.

5. Claims 16-17 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez-Estrada et al (US 2003/0035648) in view of Linnartz (US 6,947,573).

Regarding Claims 16-17 and 27, Lopez-Estrada is silent about identifying the owner of copyright and determining if requiring compensation.

In an analogous art, Linnartz discloses adding a watermark into a digital media stream to identify the owner of the copyright and trace illegal copies (Col 1 lines 16-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a watermark as taught by Linnartz with the added benefits of right protection and revenue increase.

6. Claims 32, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez-Estrada et al (US 2003/0035648) in view of Goldstein (US 5,410,326).

Regarding Claims 32, 40 and 41, Lopez-Estrada is silent about a wireless controller capable of receiving information from said first controller and displaying content segment that contain third party advertising segments.

In an analogous art, Goldstein discloses a wireless controller capable of receiving information from said first controller and displaying content segment that contain third party advertising segments (FIG.6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lopez-Estrada's system to include a wireless controller capable of receiving information from said first controller and displaying content segment that contain third party advertising segments as taught by Goldstein with added convenience to use commonly used remote control.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred Peng whose telephone number is (571) 270-1147. The examiner can normally be reached on Monday-Friday 09:00-18:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fred Peng  
Patent Examiner

Vivek Srivastava  
Supervisory Patent Examiner



VIVEK SRIVASTAVA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600